

REMARKS/ARGUMENTS

Status of the Application

Claims 2 and 7 are pending in this application. In the Final Office Action dated February 27, 2007, Claims 2 and 7 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 7-9 of co-pending U.S. Application No. 10/501,303 and Claims 1-4 of co-pending U.S. Application No. 10/540,617, respectively. In the current response, Applicants respectfully traverse these rejections. No new matter has been added.

The rejections contained in the February 27, 2007, Final Office Action were the subject of a telephone communication between Applicants and Examiner Mark Halpern on March 28, 2007. In that communication, Applicants attempted to summarize their arguments for traversal to Examiner Halpern. Examiner Halpern requested that the arguments simply be put forth in the response to the Final Office Action so that the arguments could be fully considered. Applicants herein comply with that request and fully set forth their arguments for traversal.

Double Patenting

Claim 2 was provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 7-9 of co-pending U.S. Application No. 10/501,303. Claim 7 was provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-4 of co-pending U.S. Application No. 10/540,617. Applicants note that the current application and co-pending U.S. Application Nos. 10/501,303 and 10/540,617 are all owned by a common entity, Maintech Co., Ltd.

Under the judicially created doctrine of obviousness-type double patenting, a provisional type rejection, as was issued here, is appropriate where there are two or more copending applications that were filed by the same inventive entity or that have a common assignee. MPEP § 804.I.B. As the three applications at issue here all have common ownership, this rejection passes this initial threshold of propriety. However, "[t]he 'provisional' double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application *unless that 'provisional' double patenting rejection is the only rejection remaining in at least one of the applications.*" *Id.* (emphasis added). Since

these provisional double patenting rejections are the only rejections remaining in the current application, maintaining this rejection in all applications is no longer proper. Instead, the rejections must be withdrawn in at least some of the applications.

To determine in which application the rejections are to be withdrawn, MPEP § 804.I.B.1 describes the proper action to take in the three possible situations that could arise: 1) the provisional rejection is the only rejection remaining in the *earlier filed* application and the *later filed* application is rejectable on other grounds; 2) the provisional rejection is the only rejection remaining in the *later filed* application and the *earlier filed* application is rejectable on other grounds; and 3) the provisional rejections are the only rejections remaining in *both the earlier filed and later filed* applications. The action the Examiner should take in each of these situations is as follows:

[1.] If a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.

[2.] If the ODP rejection is the only rejection remaining in the later-filed application, while the earlier-filed application is rejectable on other grounds, a terminal disclaimer must be required in the later-filed application before the rejection can be withdrawn.

[3.] If "provisional" ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application permitted to issue.

Id.

The present application has a U.S. filing date of March 23, 2001, and a priority date of September 15, 1998, to PCT Application No. PCT/JP99/05023. Co-pending U.S. Application No. 10/501,303 is the U.S. national phase application of PCT Application No. JP/02/07671, filed July 29, 2002, which claims priority to Japanese Patent Application No. 2002-5297, filed January 11, 2002. Co-pending U.S. Application No. 10/540,617 is the U.S. national phase application of PCT Application No. JP03/16799, filed December 25, 2003, which claims priority to Japanese Patent

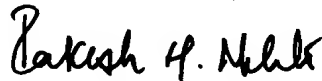
Application No. 2002-376428, filed December 26, 2002. Thus, the present application is the earliest filed application of the three applications at issue here. Because the present application is not rejectable on other grounds, but rather the provisional obviousness-type double patenting rejection is the only rejection remaining, scenarios 1. and 3. above (taken from MPEP § 804.I.B.1.) apply. Therefore, if the co-pending applications are rejectable on other grounds, then, as for the current, earlier filed application, "the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer." MPEP § 804.I.B.1. If the co-pending applications are not rejectable on other grounds, then, as for the current, earlier filed application, "the examiner should withdraw the . . . rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer." *Id.* Thus, whether the co-pending applications are rejectable on other grounds or not, the rejection in the current application should be withdrawn and the application should be allowed to issue as a patent without the filing of a terminal disclaimer. Applicants therefore respectfully request that these rejections be withdrawn and all pending claims allowed.

Summary

In view of the foregoing remarks, Applicants submit that this application is in condition for allowance and therefore respectfully request that a Notice of Allowance be issued. In order to expedite disposition of this case, the Examiner is invited to contact Applicants' representative at the telephone number below to resolve any remaining issues. Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 501447 (Potter Anderson & Corroon LLP).

Respectfully Submitted,

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